

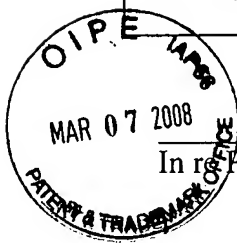
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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 03/04/08

Signature: Scott Whittemore
(Scott Whittemore)

Docket No.: SUPP-P01-011
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Blau et al.

Confirmation No.: 1982

Application No.: 10/688,747

Art Unit: 1633

Filed: October 16, 2003

For: METHODS FOR TREATING DISORDERS OF
NEURONAL DEFICIENCY WITH BONE
MARROW-DERIVED CELLS

Examiner: Q. J. Li

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Restriction Requirement mailed on February 4, 2008, Applicants provisionally make the following species elections, for search purposes only, with traverse:

- 1) A specific agent that mobilizes bone marrow cells: G-CSF.
- 2) A specific neuron deficiency: neurodegenerative disorders.
- 3) A specific neuronal factor: NGF.

Applicants submit that at least claims 2-13, 19-21, 34, 39, and 41-45 read on the elected species.

Applicants traverse the restriction, because Applicants are claiming a *genus* of methods not limited to (or even reciting) any of the specific species of agents, neuron deficiencies, or neuronal factors. Applicants are not claiming, in the broadest sense, specific *species* methods. Thus it is inappropriate for the Examiner to restrict the claimed invention to un-recited *species* in a *genus* claim, because doing so amounts to using Restriction Requirement to unjustifiably limit the scope of

independent claims that have not yet been examined on merits. Applicants note that the statutory basis for restriction practice arises under 35 U.S.C. § 121, which authorizes the patent office to require that each patent application be limited to a single invention. However, there is no basis in the statute or the rules (37 C.F.R. §§ 1.141 and 1.142) for the patent office to eliminate inventions from consideration entirely. A genus invention is as much an invention as each species. Thus, when the Examiner enumerates the various species inventions that Applicants are required to choose between, the Examiner is not authorized to omit the examination of the generic inventions altogether.

In fact, Applicants believe that the Examiner agrees with Applicants' position, because the Restriction is subject to the non-allowance of the generic / linking claims. Pursuant to MPEP 809.04, "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141 (MPEP 809.02(a)).

Furthermore, the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

In any event, Applicants' response should not be construed as an acquiescence to the Examiner's requirement for restriction or election. Applicants also reserve the right to file one or more continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

Applicants also note that the Examiner has designated claims 2, 3, 8-13, 19-21, 34, 39, and 41-50 as pending for substantive examination based on Applicants previous Reply to the original

Restriction Requirement of March 3, 2006. The Examiner has restricted out claims 4-7 as directed to a non-elected invention of the original Restriction Requirement (group I, regarding methods of treating a neuronal deficiency in a subject by administering bone marrow-derived cells). Applicants respectfully traverse the restriction.

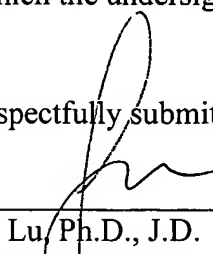
Claim 4 recites "The method of claim 34, wherein said bone marrow cells are autologous." This dependent claim recites a limitation of the cells of claim 34, which was elected in response to the original Restriction Requirement. Claim 4 does not intrinsically contain the subject matter of non-elected group 1. Rather, it is a proper dependent claim of the currently amended claim 34, which reads on a "method for producing a Purkinje/bone marrow-derived heterokaryon." Like claim 4, claims 5-7 recite different limitations on the cells of claim 34. For this reason and because the Examiner has already performed a search on the elected group, it would not be a undue burden on the Examiner to examine claims 4-7.

The Examiner is invited to telephone the undersigned to discuss any issue pertaining to this response. Applicants request favorable consideration of the application and early allowance of the pending claims.

Applicant believes no fee is due with this response. However, if any fee is due, please charge our Deposit Account No. **18-1945**, from which the undersigned is authorized to draw under Order No. **SUPP-P01-011**.

Dated: March 4, 2008

Respectfully submitted,

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